

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS**

In re)	
)	Decision on
)	Petition for Regrade
)	Under 37 C.F.R. § 10.7(c)
_____)	

MEMORANDUM AND ORDER

(Petitioner) petitions for regrading his answers to questions 11, 18, 30, 31, 33, 38, 44 of the morning section and for regrading his answers to questions 5, 7, 10, 25, 38 of the afternoon section of the Registration Examination held on August 26, 1998. The petition for the morning section is denied and the petition for the afternoon section is granted.

BACKGROUND

An applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 56 on the morning section and 68 on the afternoon section. Petitioner requested regrading of seven questions on the morning section and five questions on the afternoon section, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Commissioner.

OPINION

Under 37 C.F.R. § 10.7(c), Petitioner must establish any errors that occurred in the grading of the examination. The directions state: “No points will be awarded for incorrect answers or unanswered questions.” The burden is on petitioners to show that their chosen answers are the most correct answers. Petitioner has failed to meet this burden.

The directions to the examination state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is “All of the above,” the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO,” “PTO,” or “Office” are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of Petitioner’s arguments have been considered. For the following reasons, no points will be added to Petitioner’s score for the morning section of the examination,

and two points will be added to Petitioner's score for the afternoon section of the examination, resulting in a passing score for the afternoon section.

Morning Section

Question 11 reads as follows:

11. Jack developed a unique safety valve for use in combination with a standard boiler. The safety valve comprises a piezoelectric element which functions to adjust the opening of the valve in response to pressure build-up. His patent agent prepared and filed a proper patent application in the PTO with the following sole original claim:

The combination of a standard boiler with a safety valve, said safety valve comprising a piezoelectric element which functions to adjust the opening of the valve in reply to pressure build-up.

In the first Office action, the primary examiner properly rejected the claim over a combination of references as being unpatentable under 35 U.S.C. § 103. Thereafter, the patent agent responded by filing an amendment which substituted a new claim for the sole original claim. The new claim is also drawn to the combination of a standard boiler with a safety valve. The examiner finally rejected the new claim on same grounds as the original claim was rejected, and stating that the new claim was a substantial duplicate of all the essential features of the canceled claim. Which of the following accords with PTO practice and procedure for responding to the rejection?

- (A) File a response having an amendment which adds a single claim limited to the safety valve, accompanied by argument clearly demonstrating that the claim to the safety valve has limitations not shown in the prior art references.
- (B) File a response clearly and correctly pointing out that the new claim has limitations to particular structure not disclosed or suggested by the prior art references whether considered individually or in combination.
- (C) File a response accompanied by an affidavit under 37 CFR § 1.132 setting forth test data demonstrating the technical superiority of Jack's safety valve over the safety valves in the prior art when used in conjunction [with] pneumatic tire inflation devices.

- (D) File a petition to the Commissioner under 37 CFR § 1.81 and the proper petition fee requesting that the examiner be directed to withdraw the finality of the rejection as being premature because the new claim presented limitations not disclosed or suggested by the prior art references, and the examiner did not address those limitations in the rejection.
- (E) File a petition to the Commission under 37 CFR § 1.183 and the proper petition fee requesting that the examiner be directed to withdraw the finality of the rejection on the ground that the finality of the rejection was premature inasmuch as the new claim contained limitations not disclosed or suggested by the references, and the examiner did not address those limitations in the rejection.

Answer (B) is the most correct choice and Petitioner selected answer (D).

Answer (B) is most correct because a final rejection does not preclude consideration of further amendment or argument regarding the rejected claim. Manual of Patent Examination Procedure (“MPEP”) § 714.12 (“Once a final rejection that is not premature has been entered in a case, applicant or patent owner no longer has any right to unrestricted further prosecution [but this] does not mean that no further amendment or argument will be considered”).

Petitioner argues that a petition to withdraw finality is a proper response. However, Petitioner’s answer choice, (D), discusses a petition under 37 C.F.R. § 1.81 which is a rule entitled “[d]rawings required in patent application.” No petition procedure is set forth in this rule. Accordingly, filing a petition under that rule, which answer (D) states, cannot accord with PTO practice and procedure. Thus, answer (D) is not the most correct answer.

Petitioner asserts that “it is a reasonable inference that the test drafters intended to query in regards to 37 CFR § 1.181.” Such an assertion, however, is directly contrary to the explicit examination direction which reads “[d]o not assume any additional facts not

presented in the questions.” Accordingly, this argument and Petitioner’s accompanying points concerning the propriety of filing a petition under the question’s circumstances are unpersuasive.

Question 18 reads as follows:

18. Which of the following statements regarding design patent applications is not correct?

- (A) The specification may contain a brief description denoting the nature and environmental use of the claimed design.
- (B) The drawings may be color drawings or color photographs if accompanied by a grantable petition.
- (C) The design application may have only a single claim.
- (D) Different embodiments or modifications may be set forth in the specification, but do not need to be shown in the drawings.
- (E) The inventive novelty or unobviousness of a design resides in the shape or configuration, and/or surface ornamentation of the subject matter which is claimed.

Answer (D) is correct and Petitioner selected answer (B). Choice (D) is the most correct answer because “it is permissible to illustrate more than one embodiment of a design invention in a single application.” MPEP § 1504.05(II)(A); *see also In re Rubinfield*, 270 F.2d 391, 393, 123 USPQ 210, 212 (CCPA 1959) (“we see no reason why . . . 35 U.S.C. § 171 should, per se, preclude the showing of two or more embodiments of a design invention”). Additionally, “[t]he design must be represented by a drawing that complies with the requirements of § 1.84, and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the design.” 37 C.F.R. § 1.152(a). Accordingly, when there are different embodiments of a design, compliance with the rule’s provision that there be a sufficient number of views to constitute a “complete” disclosure of the design requires that each embodiment be set

forth in the drawings. Therefore, different embodiments or modifications of a design need to be shown in the drawings.

Answer (B) correctly states that the drawings may be color or color photographs if accompanied by a grantable petition. 37 C.F.R. § 1.152(a)(2). Answer (B) is therefore an incorrect answer choice to the question reading “[w]hich of the following statements regarding design patent applications is not correct” (emphasis in original).

Petitioner argues that answer (B) is the correct answer because “Rev. 3 of the 6th edition of the MPEP, published in July 1997, indicates in § 1503.02(E) that ‘[c]olor drawings and color photographs will not be accepted under any conditions in design patent applications’.” However, Petitioner is relying on 37 C.F.R. § 1.152 and MPEP § 1503.02(e) as they appeared before December 1, 1997. 37 C.F.R. § 1.152 was revised, effective December 1, 1997, by adding subsection (a)(2), which now states that “[c]olor photographs and color drawings are not permitted in design applications in the absence of a grantable petition pursuant to § 1.84(a)(2).” 62 Fed. Reg. 53195 (Oct. 10, 1997). Thus, the revisions were in effect well before Petitioner took the registration examination administered on August 26, 1998. The revision is reflected in the Seventh Edition of the MPEP, published in July 1998.

Petitioner further argues that (B) should be the correct answer because the July 1998 MPEP was not reasonably available at the time of the August 1998 examination, and did not become available for sale until October 28, 1998. The July 1998 MPEP also was not available on the USPTO Internet website. Despite possible unavailability of the July 1998 MPEP until after the examination, the rule changes were available to the public before the examination was administered. For instance, changes to the rules were

published in the *Federal Register* of October 10, 1997, 62 *Fed. Reg.* 53131, and in the *Official Gazette* of October 21, 1997, 1203 *Off. Gaz. Pat. Office* 63. They were made available on the USPTO Internet website, www.uspto.gov, and the PTO published and sold to the public a “Training and Implementation Guide” of the “Changes To Patent Practice and Procedure December 1, 1997.” Further, in February 1998, OED published notice on the USPTO Internet website, www.uspto.gov, that applicants would be responsible for knowing and applying the rule changes that became effective December 1, 1997. Accordingly, (B) is not a correct answer and no grading error has been shown.

Question 30 reads as follows:

30. Inventor X, a citizen of Germany, invented a tape dispenser in Germany on May 5, 1996. On January 22, 1997, X filed a patent application for the tape dispenser in the German Patent Office. On January 22, 1998, you filed a complete U.S. patent application in the PTO claiming a tape dispenser on behalf of X. The U.S. application was filed with a declaration under 37 CFR § 1.63 signed by X claiming foreign priority of the German patent application. In an Office action dated June 17, 1998, and setting a three month shortened statutory period for reply, a primary patent examiner properly rejected all the claims in the U.S. patent application as being anticipated under 35 U.S.C. § 102(a) by the disclosure in magazine articles describing how to make and use an identical tape dispenser. The articles were published in the United States in February 1997, and in Great Britain in March 1997. Which of the following actions accords with proper PTO practice and procedure, and represents the most appropriate action for overcoming the rejection?

- (A) On or before September 17, 1998, file a certified copy of the German application, and an English translation of the German application.
- (B) On or before September 17, 1998, file a certified copy of the German application, an English translation of the German application, and point out that the reference is no longer available as prior art.
- (C) File a reply on or before September 17, 1998, which argues that the reference cannot be used because the application inventor X filed in the German Patent Office antedates the article.

- (D) File an affidavit under 37 CFR § 1.132 signed by you stating that the reference cannot be used because the application which inventor X filed in the German Patent Office antedates the articles.
- (E) File a petition to have the Commissioner exercise his supervisory authority and withdraw the rejection stating that the reference cannot be properly used inasmuch as the declaration under 37 CFR § 1.63 makes clear that the application inventor X filed in the German Patent Office antedates the articles.

The correct answer is (B) and Petitioner chose answer (C). Answer (B) complies with proper PTO practice and procedure. A claim of foreign priority must be filed along with a certified copy of the foreign application, 35 U.S.C. § 119(b), and an English translation of the foreign application “when necessary to overcome the date of a reference relied upon by the examiner,” 37 C.F.R. § 1.55. Additionally, the practitioner must reply to the rejection by pointing out that the reference is no longer available as prior art. 37 C.F.R. § 1.111(b).

Answer (C) is not the most correct answer because it does not include the necessary step of filing a certified copy of the foreign application and English translation thereof. Petitioner argues that pursuant to MPEP § 201.13(b), the certified copy of the foreign application and English translation may be filed any time prior to issuance of a patent on the application. However, the question seeks “the most appropriate action for overcoming the rejection.” To overcome the rejection, the certified copy and English translation must be filed. 37 C.F.R. § 1.55. Accordingly, answer (B) which includes the required papers is a more correct answer to the question than answer (C). As shown by Form Paragraph 2.19, set forth in MPEP § 201.15, proper PTO practice and procedure is to not accept the argument in choice (C) as overcoming the rejection. Form Paragraph 2.19 reads “Applicant cannot rely upon the foreign priority papers to overcome

the rejection because a translation of said papers has not been made of record

See MPEP § 201.15.” In view of the above, no grading error has been shown.

Question 31 reads as follows:

31. Which of the following utility statements, which correspond in scope to the subject matter sought to be patented, is sufficient to meet the requirements of 35 U.S.C. §§ 101 and 112, first paragraph?

- (A) The invention is a novel process for making certain steroids which, in turn, are known to be useful in the formation of A-nor steroids. There is nothing in the record of the application file showing that any “A-nor steroid” which might ultimately be produced from the claimed compounds would itself be a useful product.
- (B) The invention is a composition which is the cure for all cancer.
- (C) The invention is a novel composition using a new source of stannous tin for incorporation in dentifrices by which term is meant mouth washes, tooth pastes, tooth powders and chewing gums, i.e., compositions for introduction into the oral cavity as cleansing compositions.
- (D) The invention is a composition which prevents the process of aging.
- (E) The invention is a device that increases the efficiency of an engine from 35% to 110%.

The correct answer is (C) and Petitioner selected answer (B). Answer (C) is the correct choice because the statement in (C) is a sufficient disclosure of a specific utility. *In re Langer*, 503 F.2d 1380, 1381, 1391-93, 183 USPQ 288, 289, 296-98 (CCPA 1974) (recited the same invention as that in (C) which was held to sufficiently disclose a specific utility); see also MPEP § 2107.01(c)(i).

Answer (B) does not sufficiently describe utility. *In re Citron*, 325 F.2d 248, 253, 139 USPQ 516, 519-20 (CCPA 1963) (“where claimed compounds are alleged in the specification to have a utility of as much public importance as is the effective treatment of cancer, which alleged utility appears to be incredible in the light of the knowledge of the art, or factually misleading, applicant must establish the asserted utility by acceptable

proof”); *In re Ruskin*, 354 F.2d 395, 399, 148 USPQ 221, 224-25 (CCPA 1966) (the application failed to have sufficient test data to support the operability of the claimed invention directed to increasing the energy release of fossil fuels).

Petitioner argues that the legal test for utility is met by his choice, citing MPEP § 706.03(a)(1), and *Langer*, and that the fact pattern does not contain an indication that one skilled in the art would question the objective truth of the statement of utility.

However, a statement alleging that a composition is a cure for all cancer is incredible on its face which does not meet the requirement in MPEP § 706.03(a)(1) that the “assertion would be considered credible by a person of ordinary skill in the art.”

Additionally, *Langer* is inapposite and does not support Petitioner’s argument because, as noted above, the claimed composition in that case was directed to dentifrices, not a cure for cancer, and the utility thereof was set forth specifically, as recited in choice (B).

Petitioner has simply cited no authority showing that the statement in (C) is credible on its face. Accordingly, no grading error has been shown.

Question 33 reads as follows:

33. The practitioner timely files an appeal brief together with an Information Disclosure Statement (IDS) disclosing references X and Y, an appropriate certification, a petition requesting consideration of the IDS, and the appropriate petition fee. References X and Y were not previously of record in the application. The primary examiner properly concludes that new rejections must be made of Claim 1 under 35 U.S.C. § 102(b) over X, and Claims 1 and 2 under 35 U.S.C. § 103 over X in view of Y. With the approval of a supervisory patent examiner, the primary examiner reopens prosecution, and enters the rejections in an Office action. Which of the following actions accords with proper PTO practice and procedure, and represents the most appropriate action for overcoming the primary examiner’s rejections?

- (A) The practitioner files a reply under 37 CFR § 1.111 together with an amendment rewriting Claim 1 to incorporate the limitations of Claim 2, and canceling Claim 2; a declaration under 37 CFR § 1.132 showing that the invention set out in amended Claim 1 produces unexpected results; and arguments in the reply pointing out the supposed errors in the examiner's rejection, and replying to each ground of rejection.
- (B) The practitioner may timely file a reply brief arguing that Claim 1 is not anticipated by reference X, and file an affidavit under 37 CFR § 1.132 in support of an argument that the invention set out in Claim 2 provides unexpected results not suggested by references X and Y.
- (C) The practitioner requests reinstatement of the appeal, and files a supplemental appeal brief accompanied by an amendment canceling Claim 1, and amending Claim 2. In the supplemental appeal brief, the practitioner argues that the rejections of Claims 1 and 2 are overcome by the amendment to the claims. The practitioner does not argue that Claims 1 and 2 are patentable independent of the amendment.
- (D) The practitioner requests reinstatement of the appeal, and files a supplemental appeal brief accompanied by an amendment canceling Claim 1, and a declaration under 37 CFR § 1.132 showing that the invention set out in Claim 2 produces unexpected results. In the supplemental appeal brief, the practitioner argues that the rejections have been overcome. The amendment and declaration are necessary to overcome the rejection.
- (E) The practitioner files a reply brief arguing that the examiner is not permitted to reopen prosecution and reject the claims, and arguing that the rejections are in error based on the practitioner's statement that the invention provides unexpected results. The practitioner's statement is otherwise unsubstantiated by evidence in the record.

Answer (A) is the correct choice and Petitioner selected answer (B).

Answer (A) is correct because in 37 C.F.R. § 1.193(b), after prosecution is reopened, amendments and affidavit evidence can be properly presented to and considered by the examiner only if the practitioner files a reply under 37 C.F.R. § 1.111, as opposed to electing to reinstate the appeal.

Answer (B) is not correct. Since prosecution has been reopened in view of the new references, the applicant has the following two choices: (1) file a reply to the Office action, or (2) request reinstatement of the appeal. 37 C.F.R. § 1.193(b)(2). Moreover, answer (B) fails to fully respond to the examiner's new rejection of claims 1 and 2 under 35 U.S.C. § 103 over X in view of Y.

Petitioner argues that there is no indication that the Office action was final or not and therefore it was most appropriate to file a reply brief. However, the two options set forth in 37 C.F.R. § 1.193(b)(2) are clear and neither includes filing a reply brief when no appeal has been reinstated. Accordingly, Petitioner's argument is unpersuasive and no error in grading has been shown.

Question 38 reads as follows:

38. Inventor A, with the assistance of a registered patent practitioner P, filed a patent application. The PTO mailed to P an Office action. P, a sole practitioner, received the Office action. The application became abandoned for failure to respond within the three month shortened statutory period for reply specified in the Office action. A asked P every three months about the status of the application. P always advised A that the application was pending. P did not revive the application. Using letters, and billing A for work not performed in the application, P mislead A into believing that the application was pending. Inventor A first learned of the abandoned status of the application in a telephone conversation with the primary examiner on June 12, 1998. On June 14, 1998, A engaged another practitioner, X, to assist in reviving and prosecuting the application. Since June 12, 1998, P has refused to respond to letters he received from A and X by certified mail, or to telephone calls from A and X, wherein A and X have requested P to provide a factual statement explaining what occurred. Inventor A, with the assistance of practitioner X, filed a petition to revive the application on August 25, 1998. Which of the following complies with PTO practice and procedure for a petition to revive an application for unavoidable delay in replying to an Office action?

- (A) Where the application was filed on May 9, 1995, and became abandoned on March 5, 1997, for no reply to an Office action dated December 4, 1996, file a petition, accompanied by the petition fee, a terminal disclaimer for 17 months which is proper in all formal respects, the disclaimer fee, the required reply, and a showing, corroborated by supporting documents and affidavits from A and X, demonstrating that P failed to inform A of the Office action, A had sought status information from P every three months since November 1996, P misled A regarding the status of the application, and P has failed to respond to communications requesting P's assistance in reviving the application, and the entire delay was unavoidable.
- (B) Where the application was filed on June 10, 1996, and became abandoned on March 21, 1997, for no reply to an Office action dated December 20, 1996, file a petition, accompanied by the petition fee, a terminal disclaimer for 17 months which is proper in all formal respects, the disclaimer fee, the required reply, and an affidavit signed by X stating that P failed to inform A of the Office action, A had sought status information from P every three months since November 1996, P misled A regarding the status of the application, and P has failed to respond to communications requesting P's assistance in reviving the application, and the entire delay was unavoidable.
- (C) Where the application was filed on April 10, 1997, and became abandoned on May 6, 1998, for no reply to an Office action dated November 5, 1997, file a petition, accompanied by the petition fee, the required reply, and an affidavit signed by X stating that P failed to inform A of the action, P misled A regarding the status of the application, and P has failed to respond to communications from A and X requesting P's assistance in reviving the application.
- (D) Where the application was filed on April 10, 1997, and became abandoned on February 6, 1998, for no reply to an Office action dated November 5, 1997, file a petition to revive accompanied by a terminal disclaimer for 3 months which is proper in all formal respects, an authorization to charge any required fees to a designated account, the required reply, and an affidavit signed by A stating that P failed to inform A of the action, and that A was damaged by P's conduct at least to the extent that A had incurred additional fees and expenses for the petition, and the entire delay was unavoidable.
- (E) None of the above.

The correct answer is (A) and Petitioner selected answer (C). The question asks which of five answers complies with PTO practice and procedure for a petition to revive an application for unavoidable delay in replying to an Office action. Answer (A) is most correct because, in accordance with 37 C.F.R. § 1.137(a) and MPEP § 711.03(c), the petition to revive includes the petition, the appropriate petition fee, a terminal disclaimer, the disclaimer fee, a reply to the last Office action, and a showing that the entire delay in the filing of the reply from the due date to the filing of a grantable petition was unavoidable. In view of evidence that the practitioner, P, concealed the abandonment from the inventor, A, billed A for work not performed, and gave misleading statements to A with regard to the application, P's lack of diligence cannot be charged to A.

See In re Lonardo, 17 USPQ2d 1455, 1458 (Comm'r Pats. 1990).

Answer (C) is not the most correct answer because it, unlike answer (A), lacks the fact that A had regularly sought status information from P. "Diligence on the part of the applicant is essential to show unavoidable delay." *Douglas v. Manbeck*, 21 USPQ2d 1697, 1700 (E.D. Pa. 1991), *aff'd*, 975 F.2d 869 (Fed. Cir. 1992). Accordingly, since there is no showing in answer (C) that A was diligent, answer (A), which includes a showing that "A had sought status information from P every three months since November 1996," is a more correct answer choice.

Answer (C) also lacks an affidavit by A which would inform the PTO what steps, if any, A took to act as a "reasonably prudent person." Such a showing is required to demonstrate unavoidable delay. *See, e.g., In re Mattullath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912). In sharp contrast, answer (A) includes such an affidavit with the

required showing of diligence by the inventor. Accordingly, overall, answer (A) is more correct than answer (C).

Petitioner argues that the affidavit makes out a prima facie case of diligence by inventor A because X's affidavit states that "P misled A regarding the status of the application" and this clearly indicates that inventor A was diligent. However, contrary to Petitioner's position, *Douglas* holds that it is the applicant's responsibility to exercise due diligence with respect to his or her application. 21 USPQ2d at 1700. Answer (C) fails to include the fact that A regularly sought status information from P and an affidavit by A showing diligence on A's part. Accordingly, no error in grading has been shown.

Question 44 reads as follows:

44. Your client, the Happy Co., has come to you and requested that you file an international application under the Patent Cooperation Treaty (PCT) which designates Canada, Mexico, and the European Patent Office. Since today, August 26, 1998, is the last day of the Paris Convention priority year, you are rushing to prepare an application which will be granted an international filing date. Given the following elements, which combination is necessary to have an international filing date granted?

- I. The designation of at least one PCT contracting state.
- II. The payment of the international fee.
- III. A part of the application which appears to be a claim.
- IV. The name(s) of the inventor(s).
- V. An application in a language prescribed by the receiving office.

- (A) I, II, and III.
- (B) I, III, and V.
- (C) I and III.
- (D) II and V.
- (E) I, III, IV, and V.

The correct answer is (B) and Petitioner chose answer (E). Answer (B) is the most correct answer. MPEP § 1810; PCT Article 11. As presented, element I is identified in section (1)(iii)(b) of PCT Article 11, element III is found in section (1)(iii)(e) of PCT Article 11, and element V is set forth in section (1)(ii) of PCT Article 11.

Petitioner contends that (E) is correct because MPEP § 1810 and 37 C.F.R. § 1.431(b)(iii) require “‘the name of the applicant’ to grant an international filing date on a PCT application,” and MPEP § 1821 and 37 C.F.R. § 1.434 indicate that an applicant can be an inventor. However, in an international application, “applicant” and “inventor” are not necessarily synonymous. As discussed in MPEP § 1817.01:

“the right to file an international application and to designate contracting states or regions (EP or OAPI) exists if the applicant is a resident or national of a contracting state. The applicant can be an individual, corporate entity or other concern. If the United States is to be designated, it is particularly important to note that the applicant must also be the inventor.”

Inasmuch as the designated states and region in the given facts do not include the United States, it is not necessary that the inventor be the applicant. Accordingly, it is not necessary to have the names of the inventors to be granted an international filing. In view of the above, no grading error has been shown.

Afternoon Section

Question 5:

Two points are awarded for question 5, thereby resulting in a passing score of 70.

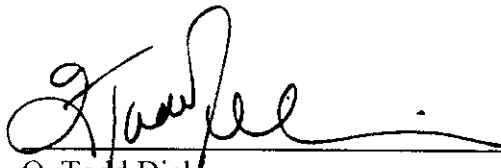
ORDER

For the reasons given above, no points have been added to Petitioner's score in the Morning Section of the Examination, and two points have been added to Petitioner's score for the Afternoon Section of the Examination. Therefore, Petitioner's Morning Section score remains at 56 which is insufficient to pass the Morning Section, and his Afternoon Section score is adjusted to 70 which is sufficient to pass the Afternoon Section.

Upon consideration of the petition to the Commissioner for a regrade, it is ORDERED that the petition be denied for the Morning Section and granted for the Afternoon Section.

This is a final agency action.

AUG 18 1999

A handwritten signature in dark ink, appearing to read 'Q. Todd Dickinson', written over a horizontal line.

Q. Todd Dickinson
Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks